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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,137

11/25/2003

Charles D. Claude

50623.339

9454

7590

10/05/2007

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EXAMINER

SILVERMAN, ERIC E

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

10/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/723,137

Applicant(s)

CLAUDE ET AL.

Examiner

Eric E. Silverman, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 15-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14 and 31-37 is/are rejected.
- 7) ☒ Claim(s) 35 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

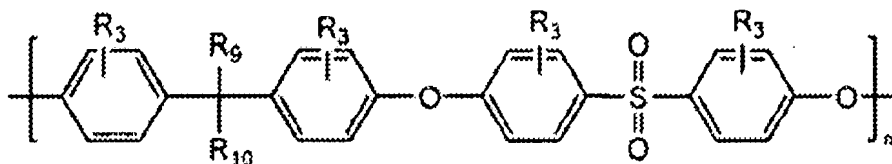
Applicants' reply, filed 8/8/2007 has been received. Claims 1 – 37 are pending. Claims 1 – 10, and 15 – 30 were previously withdrawn as being drawn to non-elected subject matter.

Response to Arguments

In response to Applicants' arguments and amendments, the rejections detailed in the office action mailed 5-11-2007 are **withdrawn**. However, the following new rejections are necessitated by the amendments and by newly discovered prior art.

Claim Objections

Claims 35 and 37 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 35 includes the structure shown below, which does not have a component which is a polyacrylate with a long side chain, polymethacrylate with a long side chain, polyhexafluoropentene, polysiloxane or combination thereof, as required by parent claim 11.



Claim 37 depends on claim 35, and does not appear to exclude this structure, which does not further limit claim 11. Note that claim 36, which is improperly dependant

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on claim 34 (*vide infra*) would also be objected to for this reason if it were properly dependant on claim 35.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 – 14 and 31 – 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites, in pertinent part, “polyacrylate with a long side chain, polymethacrylate with a long side chain”. It is not clear what is encompassed by a “long side chain” as recited. Further, it is not clear where the “long side chain” is attached to the polymer. The artisan would therefore be unable to determine the metes and bounds of the claimed invention.

The remaining claims are rejected at least for incorporating the indefinite subject matter of claim 11 by virtue of their ultimate dependence thereon.

Claim 36 recites limitations as to the nature of various R groups in claim 34. There is insufficient antecedent basis for this limitation in the claim. Claim 34 does not include any R groups.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35 – 37 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2005/0129731 to Horres et al.

Note that this rejection is being applied to dependant claims 35 – 37 but not to their parent claims. Claims 35 – 37 do not properly further limit the claims on which they depend, because they include subject matter that is outside the scope of the claims on which they depend. *Vide supra*. The prior art reference applied here anticipates the portions of claims 35 – 37 that is outside the scope of independent claim 11 and the intervening claims.

Horres teaches medical products, such as stents, which are coated with polymers (abstract). One preferred polymer is the polysulfone of paragraph [0043], which reads on instantly claimed polysulfones.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 – 14 and 31 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0129731 to Horres et al.

Horres teaches coatings for medical devices, such as stents (abstract). The polymers are polysulfones (pages 6 – 7, claims). It is suggested that the polysulfones be mixed with or made into copolymers with other polymers, such as polyhydroxyethyl

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methacrylate (a methacrylate with a long side chain). See claim 5. Drugs are included in the polymer coating (see claim 12), and the drugs suggested include the drugs of instant claim 14.

What is lacking is an explicit teaching of the instantly claimed copolymers or polymer blends.

As discussed above, Horres suggests a variety of useful copolymers or polymer blends, which include the claimed copolymers and blends.

It would be prime facie obvious to a person of ordinary skill in the art at the time of the invention to make copolymers or blends of the polysulfone with polymers such as polyhydroxyethyl methacrylate, since this is expressly suggested by Horres. The artisan would enjoy a reasonable expectation of success, since this would be merely following a clear suggestion in the prior art.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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